

In re: Asplin
Serial No.: 09/687,445

REMARKS

This Amendment follows the outstanding Official Action dated 06/16/05 and is intended as a complete and proper response thereto. In particular, the present paper is presented with the view of advancing prosecution of this application on its merits and hopefully placing this case in a clear condition for allowance.

In order to render this Amendment responsive, a Petition for Extension of Time to Respond Within the Third Month Pursuant to § 1.136(a) is submitted herewith in duplicate along with the requisite petition fee of \$510.00 commensurate with the applicant's small entity status as previously established.

Claims 12-21 remain in the application. These remaining claims are all method claims geared toward the current invention. Independent claims 12 and 17 have been amended to more particularly point out the difference in the claim as written in the current invention and the Flock patent as used by the Examiner. As such, reexamination and reconsideration of the application, as amended, is requested.

Applicant's previous amendment had added language to the claims requiring "lifting of the slab to a height above its desired final level with compressed air supplied by bursts, such that a settle cavity filled with compressed air sufficient to raise said slab above the ground is created between said slab and said ground until said compressed air escapes from said settle cavity allowing said slab to drop back into contact with said ground".

As previously argued, it was believed that this clearly and patentably defined over the previous references and in particular, the Flock 1,943,914 patent as this patent does not use air to lift with but rather uses air behind a plastic material such that the plastic material is injected between the slab and the ground to lift the slab.

Independent claims 12 and 17 have further been amended to define this lifting with air momentarily as presented in the current amendment.

In re: Asplin
Serial No.: 09/687,445

Claims 12 and 17 have currently been rejected under 35 U.S.C. § 103(a) as being unpatentable over Flock in view of Asplin 5,860,763. For prior art references to be combined to render obvious a subsequent invention under § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988). The teaching of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). Hindsight is forbidden. It is impermissible to use the claims as a framework from which to pick and choose individual references to recreate the claimed invention. *Id.* at 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The examiner has argued that Flock shows the entire claim except that Flock does not disclose the use of a well dried mason sand. The Asplin patent teaches the use of this sand to fill cavities. The Applicant agrees that he has used sand in previous patents for this however these patents do not disclose the use of air to actually lift the slab but rather generally mechanically lift the slab. The examiners action has detailed how the examiner feels Flock covers each of these steps. However when it comes to the step of lifting momentarily said slab, the examiner has not listed where he feels this is shown in Flock or how Flock shows this element.

As the applicant previously argued, Flock does not disclose the use of air pressure to lift the concrete or that the subsequent movement of dried sand to fill the void as the concrete is lifting by the air pressure. It is believed that this is now clearly presented in the claims as amended. Although a flow of sand is provided with the air pressure, it is the air pressure that lifts the slab creating a pocket of compressed air between the slab and the ground called a "settle cavity". This language is specifically included in the claims. Further, the claims also indicate how the sand is free to move around within this

In re: Asplin
Serial No.: 09/687,445

compressed air pocket during the time while the slab is raised. Although the air and sand are provided at the same time, it is the air that does the lifting until it is allowed to escape around the edges of the slab and during the time it is lifted. The sand is then free to flow to other areas of the slab typically not accessible until the slab is lifted above the ground.

As stated above, it is believed that the claim language clearly indicates this, thus differentiating it from Flock which uses the mud or granular material in order to lift the concrete or slab permanently as it is pushed under the slab. Further, it was previously argued that the use of air in Flock is counterproductive to Flock's use. It is believed that this may be clear to the examiner in light of the amendments as Flock uses a plastic non-compressible material in order to raise the concrete into place. This is clear from the claims in Flock, specifically page 2 column 2 lines 13-18 indicating that a material is forcibly injected and this material should be "substantially incompressible" filing material.

The current invention as disclosed and now claimed uses air pressure, an extremely compressible gas, in order to temporarily lift the cement allowing the sand to fill into the proper locations. Further, it is believed that the amendment of the preamble to indicate how the lifting and slab leveling is performed limits the use of the prior art which the examiner may use in this case. As such, it is believed that it has been clearly shown how the use of air or air bubbles in Flock are counterproductive to the materials and thus Flock actually teaches away from using a highly compressible material such as gas or air to temporarily lift the slab. Flock actually teaches the use of a "substantially incompressible" filing material to lift.

The applicant believes that Independent claims 12 and 17 clearly define over Flock in view of Asplin. Should the examiner wish to continue this rejection, it is kindly asked that the examiner specifically spell out exactly how he feels Flock includes the step of lifting as currently claimed or lifting as previously claimed and its limitations through the use of compressed air to a level above the desired final level in bursts as the applicant cannot find anything in Flock along these lines.

In re: Asplin
Serial No.: 09/687,445

In light of the foregoing discussion of the applied art of record, the presentation of the amended schedule of claims and the indication as to how such claims are considered to clearly and patentably define over the references, it is believed that the patentable nature of the claims has been demonstrated.

In view of the above remarks, reconsideration and allowance of the claims is kindly requested. Should any matters remain outstanding that may be handled over the phone the examiner is encouraged to call.

Date: 12-15-05

Respectfully Submitted,



Curtis V. Harr
Attorney for the Applicant
Reg. No. 37,844
P.O. Box 2842
Fargo, ND 58108-2842
Voice (701) 298-3001
Fax (701) 298-3002